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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/793,416	10/23/1997	JOHN THOMAS HARE	18872.0056	5267

25312 7590 05/25/2004

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EXAMINER	
BEHREND, HARVEY E	

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/793,416	HARE, JOHN THOMAS	
	Examiner	Art Unit	
	Harvey Behrend	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 20-26 and 30-38 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 20-26 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Sedlak et al, Breton et al or Weinberger, in view of any of Lubow, Sternlicht, Allen, Futo et al or Morrison, for the reasons set forth in section 12 of the 8/18/03 Office action.

Applicants arguments are unpersuasive of any error.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification (or even from the "Remarks" section

of an amendment) are not read into the claims. See In re Van Geuns, 26 USPQ2d 1057.

Further, statements as to possible future acts or to what may happen in a method of operation, are essentially method limitations or statements of intended or desired use and do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 152 USPQ 235; In re Otto, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP 2114 which states:

> A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647.
>
> Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.
>
> Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

Applicant is not claiming the combination of a moulded shield and a source of gamma rays.

Applicant is not claiming a method of applying a moulded shield around a source of gamma rays.

Instead, applicant is claiming a moulded shield per se.

Applicant argues that the references fail to disclose an "unsealed slit as claimed".

However, applicants claims do not recite the slit as remaining "unsealed" at all times.

Indeed, there is nothing to prevent an artisan from applying an adhesive or glue, etc., to the opposing faces forming the slit in applicants own Fig. 2 embodiment, thus helping to ensure that damaging radiation cannot stream through the slit.

In this same respect, it is noted that even applicant eventually seals (closes together) the opposing faces forming the slit (giving as an example, the use of quick-locking plastic strips, specification page 6 last 5 lines)!

While the secondary references of Lubow and Sternlicht eventually seal together, the opposing faces forming the slit, these opposing faces are at least initially during the process of assembly, etc., not sealed together. Applicants claim language does not define over such.

Applicants claims (which are to an article per se) cannot make reference to some unspecified point in time (or even for all time or for infinity) that the opposing faces forming the slit are unsealed.

Again, as pointed out above, even applicant could not prevent an artisan from sealing together with adhesive, etc., the opposing faces forming the slit in applicants moulded shield, if that is how they desired to use applicants moulded shield.

There is also nothing that would prevent an artisan from using applicants moulded shield to surround a body or component that the artisan desires to protect from a source of radiation.

Once applicants moulded shield is formed, artisans are free to use it in any manner they desire and for any purpose they desire.

Despite applicants apparent argument to the contrary, the secondary references of Allen, Futo et al and Morrison, do not utilize "sealed" slits.

4. Claims 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Sedlak et al, Breton et al or Weinberger, in view of any of Lubow, Sternlicht, Allen, Futo et al or Morrison as applied to claims 20-26 above, and further in view of Harrison and any of Cote, Fry et al or McClintock, for the reasons set forth in section 9 of the 6/17/02 Office action.

5. Claims 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Sedlak et al, Breton et al or Weinberger in view of any of Lubow, Sternlicht, Allen, Futo et al or Morrison as applied to claims 20-26 above, and further in view of any of Frevel, Labino, Japan 0052799 or Tarlow, for the reasons set forth in section 10 of the 6/17/02 Office action.

Note that Tarlow, also shows it is old and advantageous and hence obvious to wrap around a pipe carrying radioactive material, radiation shielding material in sheet form (e.g. see col. 9 lines 1+ as well as the abstract and col. 2 lines 1+). The primary references show radiation shielding material in sheet form.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 20-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in the original disclosure for taking a gamma ray source, and passing this gamma ray source through an unsealed slit (i.e. through whatever space may exist between the opposing faces forming the slit of the already moulded cylindrical shield body) into the cavity within the cylindrical shield body.

There is no support in the original disclosure for stating that it is the longitudinal slit itself which enables the tube to be fitted over a pipe. Such fitting to a pipe also requires for example, that the moulded cylindrical shield body be resilient or flexible enough to allow opening along the slit.

8. Claims 20-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There is no adequate description nor enabling disclosure of how and in what manner, one can take a gamma ray source and pass this gamma ray source through an unsealed slit (i.e. through whatever space may exist between the opposing faces

forming the slit of the already moulded cylindrical shield body) into the cavity within the cylindrical shield body.

There is no adequate description nor enabling disclosure of how and in what manner, the mere presence of a longitudinal slit in the already moulded cylindrical shield body, is by itself, sufficient to permit fitting of the already formed moulded cylindrical shield body, over a pipe, as recited in claim 20.

9. Claims 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague, indefinite and incomplete, particularly as to how and in what manner, one can take a gamma ray source and pass this gamma ray source through an unsealed slit (i.e. through whatever space may exist between the opposing faces forming the slit of the already moulded cylindrical shield body) into the cavity within the cylindrical shield body.

The claims are vague, indefinite and incomplete as to how and in what manner, the mere presence of a longitudinal slit in the already moulded cylindrical shield body, is by itself, sufficient to permit fitting of the already formed moulded cylindrical shield body over a pipe, as recited in claim 20.

The claims are vague, indefinite and incomplete as to how and in what manner, the fitting of the moulded cylindrical shield body over a pipe, permits the passage of the gamma ray source into the cavity.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications form the examiner should be directed to Harvey Behrend whose telephone number is (703) 305-1831. The examiner can normally be reached on Tuesday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where is application or proceeding is assigned is (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

HARVEY E. BEHREND
PRIMARY EXAMINER